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EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/932,714 | | JONES, DANA HOWARD | |
| | Examiner | | Art Unit | |
| | Namrata Boveja | | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/17/01 and 09/10/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-44 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 6, 9-11, 13-17, 19-22, 24-29, 31, 32, and 35-37 are rejected under 102(b) as being anticipated by Toader Patent Number 5,774,869 (hereinafter Toader).

In reference to claim 1, Toader teaches a method for offering incentives related to purchases of products or services, said method comprising the steps of: offering to a consumer a product or a service for sale (i.e. offering the consumer Internet access for a fee) (col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 2, and Figures 2 and 4); offering to said consumer an incentive related to the purchase of said product or service (i.e. offering free Internet access and software) on condition that the consumer agrees to receive or interact with an interposed communication (i.e. customer registers by completing a questionnaire, takes a guided tour of the sponsor's website, and optionally completes another survey for more free access time) (col. 2 lines 32-67, col. 4 lines 8-46, col. 5 lines 10-27, and Figure 3); and providing the offered incentive (i.e. providing free Internet access for a specified amount of time) (col. 2 lines 55-56, col. 4 lines 40-46, col. 5 lines 10-27, and Figure 3).

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3. In reference to claim 2, Toader teaches the method, wherein said incentive is provided to said consumer after an interposed communication is delivered to said consumer (i.e. customer registers by completing a questionnaire, takes a guided tour of the sponsor's website, and optionally completes another survey for more free access time) (col. 2 lines 32-67, col. 4 lines 8-46, col. 5 lines 10-27, and Figure 3).

4. In reference to claim 3, Toader teaches the method, wherein said incentive includes a discount on the purchase of said product or service (i.e. providing free Internet access for a specified amount of time) (col. 2 lines 55-56, col. 4 lines 40-46, col. 5 lines 10-27, and Figure 3).

5. In reference to claims 5 and 31, Toader teaches the method, wherein said incentive is providing the offered product or service free of charge (i.e. providing free Internet access for a specified amount of time) (col. 2 lines 55-56, col. 4 lines 40-46, col. 5 lines 10-27, and Figure 3).

6. In reference to claims 6 and 32, Toader teaches the method wherein said incentive includes providing information to said consumer (i.e. product information and sponsor's website containing other information is provided in the guided tour) (col. 2 lines 50-54 and col. 4 lines 20-23 and 34-40).

7. In reference to claims 9, 29, and 35, Toader teaches the method, wherein said incentive includes in-store coupons for discounting purchase of products or services (col. 2 lines 50-54 and col. 4 lines 20-23 and 34-40).

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8. In reference to claims 10 and 36, Toader teaches the method, wherein said interposed communication is a multimedia presentation (i.e. a guided tour with information and coupons) (col. 2 lines 50-56 and col. 4 lines 34-40).

9. In reference to claims 11 and 37, Toader teaches the method, wherein said interposed communication is an interactive survey (col. 2 lines 45-49, col. 4 lines 23-26, and col. 5 lines 10-22, and Figure 3).

10. In reference to claims 13 and 39, Toader teaches the method, wherein said interposed communication is a visual display (i.e. a webpage) (col. 2 lines 50-54, col. 4 lines 34-40, and Figure 1).

11. In reference to claims 14 and 40, Toader teaches the method, wherein said interposed communication is a link to an Internet web site (col. 2 lines 50-54, col. 4 lines 34-40, and Figure 1).

12. In reference to claim 15, Toader teaches the method, further comprising the step of selecting an interposed communication for delivering to said consumer (col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57-46, and Figures 2-4).

13. In reference to claim 16, Toader teaches the method further comprising the step of delivering to said consumer the interposed communication.

14. In reference to claims 17 and 41, Toader teaches the method, further comprising the step of requesting said consumer to provide personal identification information (col. 2 lines 45-49, col. 4 lines 23-26, col. 5 lines 10-19, and Figure 3).

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15. In reference to claims 19-21, Toader teaches the method, wherein said identification information includes said consumer's address, gender, and age information (col. 2 lines 45-49 and col. 4 lines 23-26).

16. In reference to claim 22, Toader teaches the method, further comprising the step of maintaining a database of interposed communications (col. 1 lines 22-24 and col. 4 lines 26-30).

17. In reference to claim 24, Toader teaches the method, further comprising the step of making payment to a vendor (col. 2 lines 63 to col. 3 lines 3, col. 4 lines 57 to col. 5, and Figures 2 and 4).

18. In reference to claims 25 and 42, Toader teaches the method, wherein said product or service is downloadable from the Internet by the consumer (abstract and col. 2 lines 50-54).

19. In reference to claims 26, 27, 43, and 44, Toader teaches the method, wherein said interposed communication is delivered over a communications network over a stand-alone device (i.e. a personal computer) (col. 2 lines 29-56, col. 4 lines 1-56, and Figure 1).

20. In reference to claim 28, Toader teaches the method for obtaining incentives related to purchases or products or services, said method comprising the steps of: selecting a product or service for purchase (i.e. selecting to get Internet access) (col. 2 lines 60 to col. 3 lines 3, col. 4 lines 57 to col. 5 lines 2, and Figures 2 and 4); obtaining an incentive related to the purchase of the selected product or service by agreeing to view an interposed communication (col. 2 lines 32-67, col. 4 lines 8-46, col. 5 lines 10-

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27, and Figure 3); receive an interposed communication (i.e. a survey, questionnaire, or guided tour) (col. 2 lines 32-67, col. 4 lines 8-46, col. 5 lines 10-27, and Figure 3); receive said incentive (col. 2 lines 55-56, col. 4 lines 40-46, col. 5 lines 10-27, and Figure 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 7 and 33 are rejected under U.S.C. 103(a) as being unpatentable over Robinson in view of the article titled "Free# ... 'Free' Internet offers usually carry a cost;" by Steve Alexander that was published in the Star Tribune on January 31, 2000 on pages 1-5 (hereinafter Alexander).

In reference to claims 7 and 33, Toader does not teach the method, wherein said incentive includes free telephone service. Alexander teaches the method, wherein said incentive includes free telephone service (page 1 lines 2-3, 5-7, and 9-11, page 2 lines 9-14 and 22-41, page 3 lines 1-5, and page 5 lines 4-13). It would have been obvious to modify Toader to include providing sponsored free telephone service to target users who are more interested in receiving a credit on their phone bill rather than their Internet access bill and to cater to those individuals.

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22. Claims 4, 8, 12, 18, 23, 30, 34, and 38 are rejected under U.S.C. 103(a) as being unpatentable over Toader in view of Official Notice.

In reference to claims 4 and 30, Toader does not teach the method, wherein said incentive includes paying for shipping and delivery charges related to the purchase of said product or service. Official Notice is taken that it is well known within the prior art to provide free shipping and delivery on the purchase of products to encourage users to buy the products from a vendor. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include providing free shipping and delivery of the software CD's to enable Internet access by the users, since a user may not want to go to the brick and mortar store to buy the product and to pick up the software CD and may instead prefer to buy products via phone, fax, or Internet instead to avoid having to make a trip to the store.

23. In reference to claims 8 and 34, Toader does not teach the method, wherein said incentive includes free video on demand. Official Notice is taken that it is well known within the prior art to provide free video on demand through the use of advertising that is presented on the website where videos can be downloaded to enable advertisers to reach their target audience for showing their respective advertisements. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include providing free video on demand, since once the user has Internet access he can easily go to a website to download a free video and be shown additional advertisements on that website to help pay for the cost of the video.

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24. In reference to claims 12 and 38, Toader is silent about teaching the method, wherein said interposed communication is an audio message. Official Notice is taken that it is well known within the prior art to provide interposed communication in the form of an audio message to enable advertisers to reach their target audience via telephone or via audio on the Internet. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include providing interposed communication as an audio message, since once the user has Internet access he can listen to the information from the sponsors as well read the text on the webpages, or the user may want to listen to the sponsor messages via phone and gain Internet access time in exchange for listening to the messages orally over the phone.

25. In reference to claim 18, Toader is silent about teaching the method, wherein said identification information includes said consumer's e-mail address. Official Notice is taken that it is well known within the prior art for identification to include e-mail address so that an advertiser can correspond with users via e-mail. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in the identification information a consumer's e-mail address, since advertisers may want to send electronic coupons, information, and other offers via the user's e-mail address instead of sending it to the user via regular postal mail.

26. In reference to claim 23, Toader is silent about teaching the method, further comprising the step of collecting payment from an interposed sponsor. Official Notice is taken that it is well known within the prior art to collect payment from an interposed sponsor to reimburse the service provider for his services that he provided to the end

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user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the step of collecting payment from an interposed sponsor, since the Internet Service Provider that provides the free Internet access to the user because the user agreed to view advertisements still needs to be paid by the advertiser to stay in business other than when the user pays for the Internet access himself.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.



December 31st, 2006



RETTA YEHDEGA
PRIMARY EXAMINER